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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/899,648      | 07/06/2001  | Glenn Wesley Ballard | 3520-210US          | 7727             |

7590 12/23/2004

Woodbridge & Associates, P.C.  
P.O. Box 592  
Princeton, NJ 08542

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| EXAMINER |
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PARTON, KEVIN S

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| ART UNIT | PAPER NUMBER |
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2153

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n N .

09/899,648 .

Applicant(s)

BALLARD ET AL.

Examiner

Kevin Parton

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 07/06.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. Claim 3 is objected to because of the following informalities: the word "paring" in line 1 is incorrect, the word should be "parsing". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 as written requires that a unit's request itself be parsed and a portion of the data request be returned to the unit. This is not supported by the specification. The specification describes a system where the data retrieved in response to a unit request is parsed and returned to the unit. Claim 1 has been examined in view of the description in the specification.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bjork (1999) et al. (1999) in view of Shaffer et al. (USPN 6,094,681).

6. Regarding claim 1, Bjork et al. (1999) teach a system for obtaining data on a portable unit from a server connected to a global communications network with means for:

- a. Transmitting a request for data from the portable unit to the server (figure 1; page 80, paragraph 2). Note that the PDA makes an initial request for a web page through the proxy server.
- b. Parsing the contents of the data request into strings of elements (page 80, paragraph 4; page 92, paragraph 2; page 93, paragraph 1).
- c. Transmitting at least one of the strings to the portable unit (page 81, paragraph 1).
- d. Selecting an element from the one of the strings (page 89, element 6; page 90, element 10).
- e. Transmitting the selection from the portable unit back to the server (page 90, element 10).
- f. Transmitting updated data from the server to the portable unit (page 90, element 10).

Although the system disclosed by Bjork et al. (1999) shows substantial features of the claimed invention, it fails to disclose means for selecting a relevant criteria that can be applied to the element and transmitting the updated data based on the criteria.

Nonetheless, these features are well known in the art and it would have been an obvious modification of the system disclosed by Bjork et al. (1999) as evidenced by Shaffer et al. (USPN 6,094,681).

In an analogous art, Shaffer et al. (USPN 6,094,681) discloses a system for selecting a relevant criteria that can be applied to the element and transmitting the updated data based on the criteria (column 4, lines 14-39, 57-61).

Given the teaching of Shaffer et al. (USPN 6,094,681), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system of Bjork et al. (1999) by employing periodic updates based on criteria provided by the user. This benefits the system by allowing a user of a portable system to obtain up to date information regardless of his or her access to a wired connection.

7. Regarding claim 2, Bjork et al. (1999) teach all the limitations as applied to claim 1. They further teach means wherein the transmitting steps comprise wireless transmitting steps (page 78, paragraph 1).

8. Regarding claim 3, Bjork et al. (1999) teach all the limitations as applied to claim 2. They further teach means for parsing the contents into numeric and text strings (page 81, paragraph 1).

9. Regarding claim 4, Bjork et al. (1999) teach all the limitations as applied to claim 3. They further teach means for presenting the strings as a vertical list of scrollable elements to the portable unit (page 90, figure 9, 10).

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10. Regarding claims 5 and 11, Bjork et al. (1999) teach all the limitations as applied to claims 4 and 10, respectively. They further teach means wherein the global communications network comprises the WWW (page 78, paragraph 2).

11. Regarding claim 6, Bjork et al. (1999) teach all the limitations as applied to claim 5. They further teach means wherein the portable unit is a wireless portable unit (page 78, paragraph 1; page 79, figure 1).

12. Regarding claims 7 and 12, Bjork et al. (1999) teach all the limitations as applied to claims 6 and 9, respectively. They further teach means wherein the wireless portable unit comprises a cellular telephone (page 78, paragraph 1).

13. Regarding claims 8 and 13, Bjork et al. (1999) teach all the limitations as applied to claims 6 and 9, respectively. They further teach means wherein the wireless portable unit comprises a Personal Digital Assistant (PDA) (page 79, figure 1).

14. Regarding claim 9, Bjork et al. (1999) teach a system for providing data from a global communications network based upon requests from a portable unit with means for:

- a. Parsing means for parsing the contents of data requested by the portable unit into a list of elements (page 80, paragraph 4; page 92, paragraph 2; page 93, paragraph 1).
- b. Updating means for updating data requested by the portable unit (page 90, element 10).
- c. Wherein the updated data is supplied by the server apparatus back to the portable unit based upon the element (page 90, element 10).

Although the system disclosed by Bjork et al. (1999) shows substantial features of the claimed invention, it fails to disclose means for selecting criteria that can be applied to the element and transmitting the updated data based on the criteria.

Nonetheless, these features are well known in the art and it would have been an obvious modification of the system disclosed by Bjork et al. (1999) as evidenced by Shaffer et al. (USPN 6,094,681).

In an analogous art, Shaffer et al. (USPN 6,094,681) discloses a system for selecting criteria that can be applied to the element and transmitting the updated data based on the criteria (column 4, lines 14-39, 57-61).

Given the teaching of Shaffer et al. (USPN 6,094,681), a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system of Bjork et al. (1999) by employing periodic updates based on criteria provided by the user. This benefits the system by allowing a user of a portable system to obtain up to date information regardless of his or her access to a wired connection.

15. Regarding claim 10, Bjork et al. (1999) teach all the limitations as applied to claim 9. They further teach wireless means for communicating the data between the server apparatus and the portable unit (page 78, paragraph 1).

### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see the following:

- a. Kikinis (USPN 6,076,109)

b. Herigstad et al. (USPN 6,731,316)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Parton whose telephone number is (571)272-3958. The examiner can normally be reached on M-F 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (571)272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kevin Parton  
Examiner  
Art Unit 2153

ksp



GLENTON B. BURGESS  
SUPERVISORY PAIR  
TECHNOLOGY CENTER 2150